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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91202732
Party	Plaintiff EcoWater Systems LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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ECOWATER SYSTEMS LLC,	)	
	)	
Opposer	)	Opposition No.: 91202732
	)	Serial No. 85/094,582
v.	)	Mark: ECOLAB
	)	
ECOLAB USA INC.,	)	
	)	
Applicant/Counterclaimant	)	

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**AMENDED NOTICE OF OPPOSITION**

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**ECOWATER SYSTEMS LLC**, a Delaware limited liability company located at 1890 Woodlane Drive, Woodbury, Minnesota 55125 (hereinafter, the "Opposer"), believes that it would be damaged by registration of the mark shown in Application Serial No. 85/094,582 ("the '582 Application"), filed on July 28, 2010, by Ecolab USA Inc. (hereinafter "Applicant"), published in the Official Gazette of the United States Patent and Trademark Office on May 31, 2011.

As grounds for the Opposition, it is alleged that:

1. Opposer develops and manufactures residential water treatment equipment and provides installation, cleaning, repair, and rental services related to said water treatment equipment, among other products and services.
2. Since well before the filing date of the '582 Application, Opposer has continuously used a number of "ECO-" marks, including the marks ECO PURE, ECOWATER, ECOWATER SYSTEMS, and ECOWATER DRINKING WATER & Design ("Opposer's Marks") in interstate commerce in connection with a variety of water treatment products and other goods and services.

3. When used in connection with Opposer's goods and services, Opposer's Marks are inherently distinctive.

4. Moreover, Opposer is the owner of numerous United States Trademark Registrations for Opposer's Marks and variations thereof, including but not limited to the following:

Mark	Reg. No.	Goods and Services	Appl. Date	Reg. Date
ECO PURE	1585509	water purification and filtration units for domestic and commercial use	7/31/1989	3/6/1990
ECOWATER	1555661	water treatment equipment and parts thereof, namely - residential water conditioners, domestic reverse osmosis water purifiers, and filters, ion exchangers and degasifiers for treating liquids	5/23/1988	9/12/1989
ECOWATER	2145816	bottled drinking water; distributorships in the field of bottled drinking water	8/22/1996	3/24/1998
ECOWATER SYSTEMS	1771108	water pumps, as machine parts, for use in domestic and commercial water treatment applications	5/20/1992	5/18/1993
ECOWATER SYSTEMS	1771860	repair and maintenance services in the field of domestic and commercial water treatment equipment; namely, water conditioners, softeners, deionizers, distillers, filters, and related water treatment units	2/28/1992	5/18/1993
ECOWATER SYSTEMS	1613312	retail outlet services and rental services in the field of domestic and commercial water conditioners and purifiers	9/26/1988	9/11/1990
ECOWATER DRINKING WATER & Design	2279118	bottled drinking water; retail distributorships featuring domestic and commercial water conditioners and purifiers, and bottled drinking water	5/28/1998	9/21/1999

5. All of Opposer's foregoing registrations for Opposer's Marks are valid, subsisting, and incontestable pursuant to 15 U.S.C. § 1065.

6. Opposer has used and is using Opposer's Marks in interstate commerce in connection with the goods and services described in Opposer's trademark registrations.

7. Applicant filed the '582 Application for the ECOLAB mark on July 28, 2010. The '582 application recitation of goods and services covers various goods, including, but not limited to: water filtration and purification units; water filtering apparatus; water purification tanks; and water filters ("Applicant's Goods"), without market restriction.

### **COUNT I: LIKELIHOOD OF CONFUSION**

8. Opposer repeats and realleges paragraphs 1 through 7 of the Amended Notice of Opposition as if fully set forth herein.

9. Opposer's use and registration of Opposer's Marks long pre-dates the filing date of the '582 Application.

10. The grant of a registration to Applicant for the ECOLAB mark as sought in the '582 Application to the extent it covers Applicant's Goods, or in the alternative to the extent it covers Applicant's Goods in the domestic or home markets, should be denied on the grounds of Opposer's priority of rights in Opposer's Marks. The mark sought to be registered by Applicant is confusingly similar to Opposer's Marks, and the use of the ECOLAB mark by Applicant in connection with Applicant's Goods, or in the alternative in connection with Applicant's Goods in fields other than commercial, institutional or industrial market use is likely to cause confusion or mistake in the minds of the public and to lead the public and prospective purchasers to believe that Applicant's Goods are those of Opposer or are endorsed, sponsored or otherwise affiliated or connected with Opposer, or that Opposer's goods and services are associated with Applicant, all to the damage and injury of the purchasing public and to the damage and injury of Opposer.

### **COUNT II: RESTRICTION OF GOODS UNDER TRADEMARK ACT § 18, 15 U.S.C. § 1068**

11. Upon information and belief, Applicant is not using the ECOLAB mark on or in connection with Applicant's Goods in markets other than commercial, institutional or industrial use (i.e., not in the domestic or home markets).

12. The '582 Application for the ECOLAB mark is not entitled to registration in the absence of a specified restriction to the involved application.

13. The entry of the proposed restriction to the goods in the '582 Application for the ECOLAB mark will avoid a finding of likelihood of confusion.

14. Moreover, the Applicant for the ECOLAB mark is not using its mark on those goods as set forth in the '582 Application that will be effectively excluded from the application or registration if the proposed restriction is entered.

15. As such, the restriction of a registration to Applicant for the ECOLAB mark as sought in the '582 Application to the extent it covers Applicant's Goods, or in the alternative to the extent it covers Applicant's Goods in the domestic or home markets will avoid a finding of a likelihood of confusion under Section 2(d) of the Lanham Act due to greater particularity in terms of type, use, and channels of trade of Applicant's Goods.

### **COUNT III: NO BONA FIDE USE IN COMMERCE**

16. Opposer repeats and realleges paragraphs 1-12 of the Amended Notice of Opposition as if fully set forth herein.

17. The grant of a registration to Applicant for the ECOLAB mark as sought in the '582 application to the extent it covers Applicant's Goods in the domestic or home markets should be denied on the grounds of a lack of bona fide use in commerce of the ECOLAB mark on Applicant's Goods in the domestic or home markets prior to the filing of a use-based application for registration under Section 1(a) of the Lanham Act.

18. On July 28, 2010, Applicant submitted an application for the ECOLAB mark under Section 1(a) of the Trademark Act based on use in commerce. On January 28, 2011, in an Office Action Response, Applicant stated that "[t]he Examining Attorney changed Applicant's original wording 'water filtering units for commercial, institutional or industrial use' to 'water

filtering units for domestic, commercial, or industrial use.' Applicant respectfully advises that it does not provide its units to the domestic/home market but does provide its units to the institutional market, which includes institutions such as hospitals. Applicant respectfully requests the Examining Attorney to accept its wording." Therefore, Applicant had no bona fide use of its ECOLAB mark on or in connection with domestic/home market water filtering units prior to the filing of Applicant's use-based application.

19. The restriction of a registration to Applicant for the ECOLAB mark as sought in the '582 application to delete Applicant's Goods for which Applicant did not have a bona fide use in commerce, or in the alternative to limit Applicant's Goods to markets excluding the domestic or home markets, will restrict the goods upon which Applicant uses the ECOLAB mark to those for which Applicant had a bona fide use in commerce prior to the filing of the '582 application.

**WHEREFORE**, Opposer files this Amended Notice of Opposition and prays that the aforesaid application of Ecolab USA Inc. herein opposed be restricted to the following identification of goods:

Washing machine water treatment device installed in the rinse modules of the tunnel washer to clean and reduce water consumption and the volume of discharged wastewater by re-circulating wastewater; Dispensing units for air fresheners and room deodorants; Swimming pool and spa chlorinating units; water treatment equipment, namely, dispensing units for delivering water treatment chemicals to treat scale and corrosion in boilers and cooling tower steam and water systems; electrolytic water generators for electrically decomposing tap water to generate electrolytic water and for removing chlorine odor from tap water; flashlights; portable electric fans; air filtering installations for use in operating clean rooms; chemically activated light sticks; incandescent light sticks; LED luminaires; light bulbs; ultraviolet lamps not for medical purposes; bioreactors for use in the treatment of wastewater; water filtering units not in the domestic or home markets.

Alternatively, Opposer requests that registration to Applicant for the ECOLAB mark be restricted to the following identification of goods:

Washing machine water treatment device installed in the rinse modules of the tunnel washer to clean and reduce water consumption and the volume of discharged wastewater by re-circulating wastewater; Dispensing units for air fresheners and room deodorants; Swimming pool and spa chlorinating units; water treatment equipment, namely, dispensing units for delivering water treatment chemicals to treat scale and corrosion in boilers and cooling tower steam and water systems; electrolytic water generators for electrically decomposing tap water to generate electrolytic water and for removing chlorine odor from tap water; flashlights; portable electric fans; air filtering installations for use in operating clean rooms; chemically activated light sticks; incandescent light sticks; LED luminaires; light bulbs; water filtration and purification units not in the domestic or home markets; ultraviolet lamps not for medical purposes; bioreactors for use in the treatment of wastewater; water filtering units not in the domestic or home markets; water filtering apparatus not in the domestic or home markets; water purification tanks not in the domestic or home markets; water filters not in the domestic or home markets.

Dated this 26th day of June, 2012.

Respectfully submitted,

ECOWATER SYSTEMS LLC

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## **CERTIFICATE OF ELECTRONIC FILING AND SERVICE**

I hereby certify that the foregoing document was filed electronically with the Trademark Trial & Appeal Board and that a copy was served on Applicant on June 26, 2012, via U.S. First Class Mail, in an envelope addressed as follows:

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